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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,110	06/21/2000	Terry Pullaro		7336

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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/06/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/598,110

Applicant(s)

PULLARO, TERRY

Examiner

Alvin A. Hunter

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

Responsive to the discovery of new prior art material to the prosecution, the final rejection is withdrawn and the prosecution of the Application No. 09/598110 has been reopened. A new action on the merits follow:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. In the present application, "shaped like" creates the same problem. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and

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therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 15, and 17 recites the broad recitation "handle", and the claim also recites "shaped like a grip portion" which is the narrower statement of the range/limitation. Moreover, "shaped like" is indefinite because it is not clear how similar the handle must be to be considered "shaped like".

### **Claim Rejections - 35 USC § 102**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- ✓ 2. Claims 2, 3, 9-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lay (USPN 2884816).

Lay discloses a claw hammer having a 16-ounce head (10) attached to a shank (12) having a grip portion (34) (See Figures 1 and 2; Column 4, lines 63 through 70; and Column 1, lines 1 through 33). It discloses that the claw hammer is of standard dimensions having a shank of 13 inches and has a spread across the head portion of 5 1/2 inches (See Column 4, lines 63 through 70). Being that the shank is 13 inches and spreads across the head portion by 5 1/2 inches, it would inherently have a center of mass less than 13 inches from the end of the shank. The grip portion of Lay is clearly shaped like the grip of many <sup>sports</sup> implements. *like tennis rackets*

- X 3. Claims 2, 3, 9-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoneburner (USPN 3930525).

Stoneburner discloses a soft nose hammer having a head and a handle having a pipe and grip. Because the sizes that are claimed, the center of mass is inherent as claimed (See entire document).

X 4. Claims 2-5 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (USPN 3543715).

Hill discloses an inflation testing device having a striking member, shaft and handle (See Entire Document). Since the device is to fit within the pocket of a truck driver, the length and center of mass of Hill are as stated (See Column 2, lines 10 and 11).

✓ 5. Claims 2 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman (USPN 5215307).

Huffman discloses a swing training exercise device, which can be used by golfers, tennis players, or baseball players, to strengthen specific muscles (See Background of the Invention and Abstract). The device comprises a grip portion, for the specific desired sport; and counter balancing or weights threadably connected, in which length varies with the weight (See Summary of the Invention). The total length of the exercise device is between 15 to 30 inches (See Summary of the Invention). The device would inherently have a center of mass within 13 inches of the end of the handle, when factoring in the length of the weights attached to the ends.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


X 6. Claims 4-6 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoneburner (USPN 3930525).

Stoneburner discloses that the handle may be about 10 inches (See Column 3, lines 30 through 33). At the time the invention was made it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a handle less than 10 inches and a weight having a diameter and length less than 4 inches because the applicant has not disclosed that having the handle less than 10 inches and a weight having a diameter and length less than 4 inches provides an advantage. One having ordinary skill in the art, furthermore, would have expected the applicant's invention to perform equally well with any handle length and weight diameter and length because the usage of the invention would have clearly been based upon the preference and strength of the user.


✓ 7. Claims 4, 5 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lay (USPN 2884816) in view of OFFICIAL NOTICE.

Lay does not disclose a device weighing more than the regulation implement, interchangeable handles, or a diameter or length for the head. OFFICIAL NOTICE is also taken that the tool dimensions are variable such as for use in tight spaces and;

therefore, the center of mass is dependent upon weight, shape, and size; therefore, shortening the handle, increasing the weight, or changing the shape of the head would move the center of mass closer and eventually into the head. It would have been obvious to one having ordinary skill in the art at the time the invention was made to shorten the handle, particularly to less than 10 inches, to provide a hammer for use in tight spaces or for use by housewives, as taught by the OFFICIAL NOTICE, in order to obtain a center of mass point, or balancing point, desired by the designer and user. OFFICIAL NOTICE is also taken that interchangeable parts enable the device to have more uses. In the instant case, the handle resembles a bat, golf club, tennis racket, and hockey stick.

 8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoneburner (USPN 3930525) in view of Wendt (USPN 4444396).

Stoneburner discloses a soft headed hammer having a variety of uses in sports but does not disclose the device weighing more than a regulation sporting projector. Wendt discloses a weighted golf swing exercise club in which weighs more than the regulation golf club to enable the user to strengthen his/her muscles used for golf (See Column 2, lines 36 through 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention especially in view of Wendt to adjust the weight of the Stoneburner hammer to any amount desirable.

 9. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoneburner (USPN 3930525) in view of Wendt (USPN 4444396) in further view of OFFICIAL NOTICE.

Stoneburner in view of Wendt does not disclose the handle being interchangeable with other shapes of handles. OFFICIAL NOTICE is also taken that interchangeable parts enable the device to have more uses. In the instant case, the handle may resemble a bat, golf club, tennis racket, and hockey stick.

✓ 10. Claims 2-5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breuner (USPN 6138879).

Breuner discloses a mallet tool for creating proper pocket formation in athletic ball catching gloves having a handle attached to a sports ball, or head (See Abstract). The handle has a length of 6 to 12 inches from where the handle meets the head and may be styled and dimensioned like that of the handle of a youth baseball bat (See Summary of the Invention; and Column 2, lines 45 through 50). The head is configured to look and feel like a regulation ball, such as a 3-inch diameter baseball, and can be threadably attached to the handle (See Column 2, lines 33 through 44; and Column 3, lines 12 through 31). The device inherently has a center of mass less than 13 inches from the end of the handle. OFFICIAL NOTICE is also taken that the center of mass is dependent upon weight, shape, and size; therefore, shortening the handle, increasing the weight, or changing the shape of the head would move the center of mass closer and eventually into the head. It would have been obvious to one having ordinary skill in the art at the time the invention was made to shorten the handle, particularly to less than 10 inches, as taught by the OFFICIAL NOTICE in order to obtain a center of mass point, or balancing point, desired by the user. In the instant case, the handle may resemble a bat, golf club, tennis racket, and hockey stick.



- ✓ 11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breuner (USPN 6138879) in view of Wendt (USPN 4444396).

Breuner does not disclose the device weighing more than a regulation sporting projector. Wendt discloses a weighted golf swing exercise club in which weighs more than the regulation golf club to enable the user to strengthen his/her muscles used for golf (See Column 2, lines 36 through 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the invention weight more than the regulation sporting projector, such as a golf club, bat, tennis racket, hockey stick, used in a particularly sport, such as golf, hockey, baseball, tennis, in order to strengthen the user's muscles used for a sport.

- ✓ 12. Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton et al. (USPN 5312308) in view of Huffman (USPN 5215307).

Hamilton et al. discloses a forearm apparatus to exercise the forearm muscles (See Summary of the Invention). The apparatus includes an elongated handle and plurality of weighted ring on the end of the handle (See Summary of the Invention). It is noted that the apparatus the optimum dimensional relationships for the parts of the invention, to include variations in size, material, shape, form, function and manner of operation, assembly and use are deemed apparent and obvious (See Column 4, lines 3 through 11). Therefore, since Hamilton et al. discloses an invention with the same parts and the same purpose, the dimensions and center of mass of the device would have been obvious because there is no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful. (See MPEP

2123 and Merck & Co. Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843). Hamilton et al. does disclose the grips of various sport implements. Huffman discloses a swing training exercise device, which can be used by golfers, tennis players, or baseball players, to strengthen specific muscles (See Background of the Invention and Abstract). The device comprises a grip portion, for the specific desired sport; and counter balancing or weights threadably connected, in which length varies with the weight (See Summary of the Invention). The total length of the exercise device is between 15 to 30 inches (See Summary of the Invention). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Huffman, to make the length of the Hamilton device of about 15 inches to reduce the size, which would inherently make the center of mass 13 inches or less.

### ***Response to Arguments***

Applicant's arguments with respect to claims 2-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

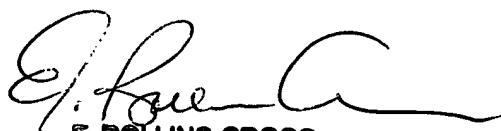
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700

Approval for Reopening Prosecution



E. ROLLINS CROSS  
GROUP DIRECTOR  
TECHNOLOGY CENTER 3700